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EXAMINER				
JOHNS, CHRISTOPHER C				
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3621				
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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

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# Office Action Summary

**Application No.**

09/681,017

**Applicant(s)**

DURBIN ET AL.

**Examiner**

Christopher C. Johns

**Art Unit**

3621

**Period for Reply** -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 23 April 2010.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1, 4-23, 25 and 26 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1, 4-23, 25 and 26 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SF/02)
- 4) ☐ Interview Summary (PTO-413)
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_
- Paper No(s)/Mail Date \_\_\_\_\_

## **DETAILED ACTION**

### ***Acknowledgements***

1. This Office Action is given Paper No. 20100701 for reference purposes only.
2. This Office Action is in response to the Response to Non-Final Office Action of 23 February 2010 ("Rejection of February 2010"), as filed by Applicants on 23 April 2010 ("Remarks of April 2010", or simply "Remarks").
3. Claims 1, 4-23, 25, and 26 are pending.
4. Claims 1, 4-23, 25, and 26 have been examined.

### ***Claim Rejections - 35 USC § 103***

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 1, 4-7, 10, 15, 23, 25, and 26 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent 5,956,505 ("Manduley") in view of U.S. Patent 6,402,737 ("Tajima").
7. As per claim 1, Manduley discloses:
8. receiving an option-enabling request (figure 4-A, reference 206) from the user specifying an option requested to be enabled (column 7, lines 61-64 - "received request code in order to [determine] what...features are requested to be activated") in equipment at a subscribing station (figure 1, reference 20);

9. at the centralized facility (column 6, lines 51-53 - "data center"), confirming that the option has not already been enabled (column 8, lines 2-5 - "data center checks to see whether the request code included a request to activate a feature or program that...was already activated");
10. generating an enabling feature at the centralized facility (figure 4-B, reference 224) upon confirmation that the option has not already been enabled (column 8, lines 6-13 - "Otherwise, step 216 follows step 212"), the enabling feature comprising a software key (figure 4-B, reference 224) designed to enable software already installed in the equipment (column 2, lines 35-40 - "storing in the memory a number of applications...at least one of them applications programs including at least one optional feature");
11. sending the enabling feature from the centralized facility to the equipment in the subscribing station (figure 4-B, reference 228);
12. activating the option in the equipment (column 2, lines 59-60 - "operating the requested feature if the requested feature was determined to be activated").
13. Manduley does not explicitly disclose:
14. receiving a user ID at a centralized facility from a user.
15. Tajima teaches:
16. receiving a user ID (figure 6, reference 601) at a centralized facility (figure 1, reference 127) from a user (figure 1, reference 114).
17. Tajima teaches authenticating a user against a database (figure 1, reference 127) in order to create a more secure system. By preventing unauthorized users from operating medical equipment, "an error in view of software of transmitting erroneous operational procedure

description to the devices can be prevented” (column 2, lines 59-61). This creates a system where only authorized users are allowed to operate the machinery, thereby reducing the possibility of surgical/medical errors. This, in turn, would create a more profitable system for its creators, because a person having ordinary skill in the art would understand that users are more likely to purchase and use a system that can prevent surgical and other medical errors.

18. Therefore, it would have been obvious to a person having ordinary skill in the art to include in Manduley the user authentication system as taught by Tajima, since the claimed invention is merely a combination of old elements, and in the combination, each element merely would have performed the same function as it did separately. A person having ordinary skill in the art would have recognized that the results of the combination were predictable, as well as advantageous because it would create a more safe, secure, and profitable system.

19. Claims 10 and 23 are substantially similar to claim 1, and are similarly rejected.

20. As per claims 4, 5, 15, and 25, Manduley in view of Tajima discloses as above, and further discloses:

21. equipment includes medical imaging scanners (Tajima, figure 1, reference 117);

22. designing a software key to enable the option for a predetermined trial period (column 7, lines 10-14 - “temporary activation allows a user to have use of a feature on a rental or free trial basis”).

23. As per claims 6, 7, and 26, Manduley in view of Tajima discloses as above, and further discloses:

24. authenticating the user ID after receiving it at the centralized facility (Tajima, reference 604);

25. downloading the enabling feature to the equipment and remotely enabling the feature automatically and without further user input (column 2, lines 59-60 - "operating the requested feature if the requested feature was determined to be activated").

26. Claims 7 and 26 are alternatively rejected under 35 U.S.C. 103(a) as being unpatentable over Manduley in view of Tajima<sup>1</sup>.

27. It is the Examiner's primary position that the claims are anticipated because the above-mentioned features (i.e. "remotely enabling the feature automatically") are inherent. However, it would have been obvious to a person having ordinary skill in the art to provide an automatic mechanism for performing this same task. See MPEP §2144.04(III) and *In re Venner*, 262 F.2d 91, 95, 120 USPQ 193, 194 (CCPA 1958): "broadly providing an automatic or mechanical means to replace a manual activity which accomplished the same result is not sufficient to distinguish over the prior art". This would also create a more profitable system; a system that operates more quickly also is more likely to be purchased and used by a customer, because users are more likely to buy a faster-operating system due to the efficiency involved.

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<sup>1</sup> MPEP §2112.III authorizes a secondary 35 USC §103 rejection, when the "the composition of the prior art is the same as that of the claim but the function is not explicitly disclosed by the reference". A second §103 rejection has been made to avoid any potential questions of inherency.

28. Therefore, it would have been obvious to a person having ordinary skill in the art to include in Manduley and Tajima an automatic means for enabling a feature, since the claimed invention is merely a combination of old elements, and in the combination, each element merely would have performed the same function as it did separately. A person having ordinary skill in the art would have recognized that the results of the combination were predictable, as well as advantageous because it would create a faster and more profitable system.

29. Claims 8, 9, 11-14, and 16-22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Manduley in view of Tajima, further in view of Admitted Prior Art (under MPEP §2144.03 C).

30. As per claims 11, 12, and 18, Manduley in view of Tajima discloses as above, but does not explicitly disclose:

31. receive a system ID and validate the system ID;

32. generate an option key specific to the system ID.

33. It is now Admitted Prior Art (under MPEP §2144.03 C) that receiving and validating a system ID, as well as generating a key specific to a system ID, were old and well-known in the art because they create a more secure system, whereby only authorized units are able to utilize specific software. By preventing an unauthorized unit (i.e. a unit whose system ID is not valid) from accessing proprietary software, the system is more secure; this leads to a more profitable system, because users are more likely to purchase and use a more secure system.

34. Therefore, it would have been obvious to a person having ordinary skill in the art to include in Manduley and Tajima the usage of authenticated system IDs, as well as option keys

generated specifically for a system ID, since the claimed invention is merely a combination of old elements, and in the combination, each element merely would have performed the same function as it did separately. A person having ordinary skill in the art would have recognized that the results of the combination were predictable, as well as advantageous because it would create a more secure and profitable system.

35. As per claims 8 and 16, Manduley in view of Tajima discloses as above, but does not explicitly disclose:

36. sending enabling feature by email to a field engineer for manual installation and enablement.

37. It is now Admitted Prior Art (under MPEP §2144.03 C) that sending information via email, and activating via email was old and well-known in the art because it creates a system that is more reliable and quick than postal mail. Rather than send enabling information via postal mail (which can take weeks to be received, and is costly to confirm receipt), it was well-known to those skilled in the art at the time of the invention to send enabling information via email; a user can be sent the enabling information immediately and confirm it with the distributor immediately (e.g. via a phone call, or an email reply). This, in turn, creates a more profitable system, because users are more likely to purchase and use a system that operates in a faster manner.

38. Therefore, it would have been obvious to a person having ordinary skill in the art to include in Manduley and Tajima the concept of emailing enabling information since the claimed invention is merely a combination of old elements, and in the combination, each element merely



would have performed the same function as it did separately. A person having ordinary skill in the art would have recognized that the results of the combination were predictable, as well as advantageous because it would create a faster-operating as well as more profitable system.

39. As per claim 9, Manduley in view of Tajima discloses as above, but does not explicitly disclose:

40. sending a verification email to the user confirming option enablement.

41. It is now Admitted Prior Art (under MPEP §2144.03 C) that sending option confirmation information via email was old and well-known in the art because it creates a system that is more reliable and quick than postal mail. Rather than send confirmation information via postal mail (which can take weeks to be received, and is costly to confirm receipt), it was well-known to those skilled in the art at the time of the invention to send enabling information via email; a user can be sent the confirmation information immediately and confirm it with the distributor immediately (e.g. via a phone call, or an email reply). This creates a more reliable system, because users will possess a copy of information that proves that their software was enabled. This, in turn, creates a more profitable system, because users are more likely to purchase and use a system that operates in a faster manner.

42. Therefore, it would have been obvious to a person having ordinary skill in the art to include in Manduley and Tajima the concept of emailing confirmation information since the claimed invention is merely a combination of old elements, and in the combination, each element merely would have performed the same function as it did separately. A person having ordinary skill in the art would have recognized that the results of the combination were predictable, as

well as advantageous because it would create a faster-operating, more reliable, and more profitable system.

43. As per claims 13 and 14, Manduley in view of Tajima, further in view of Admitted Prior Art (under MPEP §2144.03 C), discloses as above, and further discloses:

44. computer is further programmed to send an electronic verification of the option enablement (column 8, lines 47-51 - “confirmation code...to be transmitted to the data center”).

45. As per claim 17 and 19, Manduley in view of Tajima, further in view of Admitted Prior Art (under MPEP §2144.03 C), discloses as above, and further discloses:

46. option key with a disablement feature to disable the option after a predetermined time period (“temporary activation allows a user to have use of a feature on a rental or free trial basis”).

### ***Claim Interpretation***

47. The Examiner hereby adopts the following definitions under the broadest reasonable interpretation standard. In accordance with *In re Morris*, 127 F.3d 1048, 1056, 44 USPQ2d 1023, 1029 (Fed. Cir. 1997), the Examiner points to these other sources to support his interpretation of the claims. Additionally, these definitions are only a guide to claim terminology since claim terms must be interpreted in context of the surrounding claim language. Finally, the following list is not intended to be exhaustive in any way:

48. **Allow:** “3 b : to forbear or neglect to restrain or prevent.” Webster’s Ninth New Collegiate Dictionary, Merriam-Webster Inc., Springfield MA, 1986.
49. **As:** “2 : for instance <various trees, ~ oak or pine>.” Merriam-Webster’s Collegiate Dictionary, 10<sup>th</sup> edition, Merriam-Webster Inc., Springfield MA, 1997.
50. **Network:** “(2) (a) (data transmission) a series of points interconnected by communication channels.” The Authoritative Dictionary of IEEE Standards Terms, 7<sup>th</sup> Ed., IEEE, Inc., New York, NY, 12/2000.
51. **Online:** “*adj.* 1. In reference to a computing device or a program, activated and ready for operation; capable of communicating with or being controlled by a computer. 2. In reference to one or more computers, connected to a network.” Microsoft Computer Dictionary, 5<sup>th</sup> Edition. Microsoft Press, Redmond, WA, 2002.
52. **Remote:** “not in the immediate vicinity, as a computer or other device located in another place (room, building, or city) and accessible through some type of cable or communications link.” Microsoft Computer Dictionary, 5<sup>th</sup> Edition. Microsoft Press, Redmond, WA, 2002.

***Response to Arguments***

53. Applicant's arguments filed with the Remarks of April 2010 have been fully considered but they are not persuasive.

54. **Applicants argue:** “[as per claims 1, 10, and 23,] there is simply no teaching or suggestion provided in Tajima of receiving a user I.D. at a centralized facility...that is separate/remote from the surgical apparatus itself...” (Remarks, page 8, ¶3 - page 10, ¶2).

55. **Examiner's response:** The Examiner disagrees both with Applicants' argument as well as Applicants' assertion of the content of claims 1, 10, and 23.

56. Firstly, none of claims 1, 10, and 23 recite that the “centralized facility” is “separate/remote” from the “surgical apparatus.” Claim 1 recites “a centralized facility” and a “subscribing station,” but does not recite the limitation that the “centralized facility” and the “subscribing station” are “remote/separate” from one another. Claim 10 recites a “subscribing station” and an “on-line center,” but does not recite the limitation that the “subscribing station” and the “on-line center” are “remote/separate” from one another. Claim 23 recites a “centralized facility” and a “subscribing station,” but does not recite the limitation that the “centralized facility” and the “subscribing station” are “remote/separate” from one another.

57. Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

58. Secondly, even if there were a recitation that the “centralized facility” and “surgical apparatus” were “separate/remote” from one another, Tajima does teach this limitation. Note that Tajima's User Authenticating Means 127 is connected to the supervisory controlling means

**126**, which in turn is connected to the work environment data detecting means **104**, which is in turn connected to the diseased tissue manipulating means **102**. The User Authenticating Means **127** connects through a transmission path **128**, which is understood to be “a network or an exclusive communication network” (column 4, lines 55-60). Therefore, as the User Authenticating Means **127** is connected to the Diseased Tissue Manipulating Means **102** via a “network,” this satisfies the definition of “remote” (“not in the immediate vicinity...accessible through some type of cable or communications link”). Furthermore, because the User Authenticating Means **127** operates over a network, the User Authenticating Means **127** is also an “on-line center” as per the above definition of “online” (“2. In reference to one or more computers, connected to a network”).

59. Therefore, even if claims 1, 10, and 23 contain the limitation of an “on-line center” “remote” from the subscriber station, the claim language is met nonetheless, and Applicants’ arguments are unconvincing.

60. **Applicants argue:** “Examiner failed to address the element(s) in claim 18 setting forth the steps of comparing the option-enabling request with any other option requests for that system I.D. in the database at the on-line system...” (Remarks, page 10, ¶4).

61. **Examiner’s response:** The Examiner disagrees.

62. In Paper Number 20100210 at ¶15, the Examiner noted that the “data center checks to see whether the request code included a request to activate a feature or program that...was already activated”, citing column 8, lines 2-5 for support. The data center, in checking to see if the program is already activated, would receive an indication of matches in the “customer’s file”

(column 8, line 1). Note that this is done to check whether the “request is appropriate” (column 8, lines 1-2). See figure 4-A, reference 212, where it is noted that an “Error” will result in an “Error Message” (214), which in turn will not generate the activation code in 224. Finally, claim 18 is noted, at ¶35-39, as containing the same limitations “as above.”

63. As such, the Examiner did address the claim limitations, and Applicants’ arguments are unconvincing.

64. **Applicants argue:** “Applicant believes that the Examiner’s application of Official Notice is inappropriate under the MPEP...[because he attempted] to fill-in apparent ‘holes’ in the rejections rather than ‘gaps’” (Remarks, page 10, ¶5 - page 11, ¶3).

65. **Examiner’s response:** The Examiner disagrees. Firstly, Applicants provide no definitions for “holes” or “gaps,” nor do Applicants provide any evidence as to why the statements that the Examiner took Official Notice regarding were “holes” rather than “gaps.”

66. Secondly, Applicants’ attempt at traversing the Official Notice findings as stated in the previous Office Action (Paper No. 20100210, Paragraph No. 39-40) is inadequate. Adequate traversal is a two step process. First, applicants must state their traversal on the record. Second, and in accordance with 37 C.F.R. §1.111(b), which requires applicants to specifically point out the supposed errors in the Office Action, applicants must state why the Official Notice statements are not to be considered common knowledge or well known in the art.

67. In this application, while Applicants have clearly met step (1), Applicants have failed step (2) since they have failed to argue why the Official Notice statements are not to be considered common knowledge or well known in the art. Because Applicants’ traversal is

inadequate, the Official Notice statement(s) are taken to be admitted as prior art. See MPEP §2144.03.

68. Finally, see Beery (U.S. Patent Application Publication 20010034846), ¶[0046] - “If user information is authenticated, the installation process 224 begins on installation server 204 to authenticate previous valid uses of data or software occurred on a valid computing device...computing device data 232 is received 233 by first hardware helper program 206 and sent 236 to authentication server 208. Computing device data 232 is forwarded 240 to registration database 210. Registration database server 210 queries database to find pre-existing user and machine data registrations. Matching previous registrations are compared against present user and computing device information; if authenticated by authentication server 208 the installation continues.” The “computing device data” 232 is used as identification for the system, in order to authenticate users’ computers, before allowing them to use specific software packages.

69. Therefore, because Applicants’ traversal is inadequate, and because the Examiner has provided prior art which demonstrates the features which are the subject of the “Official Notice” statements, Applicants’ arguments are unconvincing.

70. **Applicants argue:** “Applicant believes that the Examiner’s application of Official Notice is inappropriate under the MPEP...[because he attempted] to fill-in apparent ‘holes’ in the rejections rather than ‘gaps’” (Remarks, page 11, ¶4 - page 12, ¶1).

71. **Examiner’s response:** The Examiner disagrees. Firstly, Applicants provide no definitions for “holes” or “gaps,” nor do Applicants provide any evidence as to why the statements that the Examiner took Official Notice regarding were “holes” rather than “gaps.”

72. Secondly, Applicants’ attempt at traversing the Official Notice findings as stated in the previous Office Action (Paper No. 20100210, Paragraph No. 41-48) is inadequate. Adequate traversal is a two step process. First, applicants must state their traversal on the record. Second, and in accordance with 37 C.F.R. §1.111(b), which requires applicants to specifically point out the supposed errors in the Office Action, applicants must state why the Official Notice statements are not to be considered common knowledge or well known in the art.

73. In this application, while Applicants have clearly met step (1), Applicants have failed step (2) since they have failed to argue why the Official Notice statements are not to be considered common knowledge or well known in the art. Because Applicants’ traversal is inadequate, the Official Notice statement(s) are taken to be admitted as prior art. See MPEP §2144.03.

74. Finally, as per claims 8 and 16, see Patel et al (U.S. Patent 7007274), column 1, lines 42-50 - “it is often necessary for an engineer to install software to “fix” or correct the bug...in the past, a field engineer would have to travel to each of the workstations individually and install software or software patches (as indicated in part in FIG. 1).”



75. Finally, as per claim 9, see Wookey et al (U.S. Patent 6,237,114), column 19, lines 55-60 - “the patch is then copied back up to the customer, and an E-mail is generated indicating to the customer that the patch or other solution has arrived and the solution needs to be implemented as soon as possible.”

76. Therefore, because Applicants’ traversal is inadequate, and because the Examiner has provided prior art which demonstrates the features which are the subject of the “Official Notice” statements, Applicants’ arguments are unconvincing.

### ***Conclusion***

77. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

78. A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

79. Any inquiry concerning this communication or earlier communications from the Examiner should be directed to Christopher C. Johns whose telephone number is (571)270-3462. The Examiner can normally be reached on Monday - Friday, 9 am to 5 pm.

80. If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's supervisor, Andrew Fischer can be reached on (571) 272-6779. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

81. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Christopher C Johns/  
Examiner, Art Unit 3621

/Calvin L Hewitt II/  
Supervisory Patent Examiner, Art Unit 3685